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In re Patent of :
Baker, et al. :
Patent No. 7,033,786 : ON PETITION
Issued: April 25, 2006 :
Application No. 10/015,715 :
Filed: December 12, 2001 :
Attorney Docket No. GNE.2830P1C56 :

OFFICE OF PETITIONS

This is a decision on the request for reconsideration of the March 28, 2006 decision dismissing petitioners' request for a Corrected Filing Receipt and the petition filed in the alternative under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 365(c) for the benefit of the prior-filed nonprovisional and PCT applications set forth in the amendment filed September 9, 2002 (certificate of mailing date August 29, 2002).

The petition under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

The application was filed on December 12, 2001. It is noted that the December 12, 2001 Preliminary Amendment listed the applications for which benefit is sought. However, the relationship between the applications was missing in some instances. The current procedure where a claim for priority under 37 CFR 1.78(a)(3) is not properly presented and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth improperly, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).¹

Application No. 09/403,297 was not listed on the Patent Application Publication. Therefore, the Office did not note the improper claim for benefit of Application No. 09/403,297. Further, while the

¹ Note MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

Office noted the reference to PCT/US00/0342, it was published as one claiming foreign priority rather than domestic.

A petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 is required to claim the benefit of application no. 09/403,297 and PCT/US00/0342.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application.

The preliminary amendment filed on December 12, 2001 only states the relationship between the present application and Application No. 09/946,374. No relationships are stated with respect to the other non-provisional and PCT applications. Listing the application number is not enough. Relationships between applications must be stated.

A preliminary amendment listing the relationships between applications was filed on September 9, 2002 (certificate of mailing date August 29, 2002). However, the amendment was not filed within either 4 months of the application's filing date, or 16 months of the filing date of the prior filed application, whichever is later. Therefore, the amendment was not timely filed and a petition under 37 CFR 1.78(a)(3) is required.

The petition under 37 CFR 1.181 for reconsideration of the March 28, 2006 decision on petition is dismissed.

A review of the file record fails to disclose that a claim for the benefit of priority to the prior-filed nonprovisional and PCT applications was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and further failed to include a proper reference to the prior-filed application as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed December 12, 2001.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3) is the appropriate avenue of relief to

accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP 1481.

In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. §§ 120 and 365(c) is accepted as being unintentionally delayed.

No further action is required in this case.

Any questions concerning this matter may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272- 3230.



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Office of Petitions